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IN THE

Supreme Court of the United States

INFINEON TECHNOLOGIES AG,
INFINEON TECHNOLOGIES NORTH AMERICA CORP., AND
INFINEON TECHNOLOGIES HOLDING NORTH AMERICA INC.,
Petitioners,

v.

RAMBUS, INC.,
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF ROBERT L. HARMON AS *AMICUS CURIAE* SUPPORTING PETITIONERS

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INTEREST OF AMICUS CURIAE [1]

I, Robert L. Harmon, am the author of *Patents and the Federal Circuit*, a treatise that surveys Federal Circuit jurisprudence, now in its sixth edition. In 1997, I retired from Brinks Hofer Gilson & Lione in Chicago, Illinois, after thirty-two years of practicing patent law. I have served, and am presently serving, as a special master in several patent cases. I have also served as an expert witness and consultant in patent litigation. I am a member of the Bar of this Court.

I have no stake in any of the parties to this litigation or the result of this case. My only interest, as described below, is in seeking a consistent and predictable methodology for performing claim construction. Counsel for petitioners and respondent have consented to the filing of this brief. Their consent letters have been filed with the Clerk of the Court.

ARGUMENT

This Court has often stated that "'in most matters it is more important that the applicable rule of law be settled than that it be settled right.'" *Agostini v. Felton*, 521 U.S. 203, 235 (1997) (citation omitted). In 1996, this Court stepped in to settle the question of whether claim construction is a question of the law for the trial court or a question of fact for the jury. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996). This Court has, in the case at hand, an opportunity to define the appropriate methodology that is to be applied in construing claims. At a time when the Federal Circuit devotes a very substantial portion of its judicial effort to the claim construction exercise, the importance of this matter to the lower courts, the patent bar, and the commercial world can hardly be overstated.

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[1] No counsel for a party authored this brief in whole or in part. No person or entity has made a monetary contribution to the preparation or submission of this brief.

The ability to assess the scope of claims using a regularized methodology, to achieve predictable results, is fundamental to our patent system. This Court recently emphasized the point in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*:

> The [patent] monopoly is a property right; and like any property right, its boundaries should be clear. This clarity is essential to promote progress, because it enables efficient investment in innovation. *A patent holder should know what he owns, and the public should know what he does not.*

___U.S. ___, 122 S.Ct. 1831, 1837 (2002) (emphasis added). Just as the tools and methods a surveyor employs are essential to ascertaining the boundaries of real estate, so are the tools and methods employed to construe claims essential to ascertaining the boundaries of patent rights. Claim construction is the process by which a Court, patentee or competitor ascertains the scope of the patent right. Unfortunately, there is confusion in the bar and the lower courts as to what tools should be used to perform that process and how and when these tools should be used.

The confusion relates to the respective roles of the patent specification and the dictionary in the claim construction process. In recent years the Federal Circuit has developed two lines of precedent that are difficult to harmonize. One line emphasizes the role of the specification in the claim construction process (*see, e.g., O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576 (Fed. Cir. 1997); *Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295(Fed. Cir. 1999); *Wang Labs., Inc. v. Am. Online, Inc.*, 197 F.3d 1377 (Fed. Cir. 1999); *Watts v. XL Sys., Inc.*, 232 F.3d 877 (Fed. Cir. 2001); *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys.*, 242 F.3d 1337 (Fed. Cir. 2001); and *Bell Atl. v. Covad Communications Group, Inc.*, 262 F.3d 1258 (Fed. Cir. 2001). The other line de-emphasizes the role of the specification and emphasizes the "ordinary meaning" of claim

terms (*see, e.g. Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985 (Fed. Cir. 1999); *CCS Fitness v. Brunswick Corp.*, 288 F.3d 1359 (Fed. Cir. 2002); and *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002)). That line, recently, has accorded preeminence to the role of the dictionary in ascertaining the ordinary meaning of disputed claim terms (*see, e.g. Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002)).

By way of illustration, consider one outstanding example of the direct conflict between these competing methodologies. The Federal Circuit's watershed decision in *Vitronics Corp. v. Conceptronic Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996), tells us that "[i]t is well-settled that, in interpreting an asserted claim, the court should look *first* to the intrinsic evidence of record, *i.e.*, the patent itself, including the claims, the specification and, if in evidence, the prosecution history," and that dictionaries are "extrinsic evidence," albeit evidence that may be consulted "when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." 90 F.3d 1576, 1582 (Fed. Cir. 1996) (emphasis supplied). In *Texas Digital*, the same Court tells us that "[a] dictionary is not prohibited extrinsic evidence," and warns us that "[c]onsulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims." 308 F.3d at 1204.

This potential for confusion has not gone unnoticed. In *SciMed*, Judge Dyk stated in his concurrence:

> The problem is that our decisions provide inadequate guidance as to when it is appropriate to look to the specification to narrow the claim by interpretation and when it is not appropriate to do so. Until we

> provide guidance, I fear that the lower courts and litigants will remain confused.

242 F.3d at 1347. Judge Dyk's admonition has proved prescient. A number of commentators and lower courts have expressed frustration and confusion with the state of claim construction jurisprudence. *See, e.g.*, Gregory J. Gallagher, Recent Development: *The Federal Circuit and Claim Construction: Resolving the Conflict Between The Claims and the Written Description*, 4 *N.C.J.L. & Tech.* 121, 121 (2002) ("Conflicting standards of claim construction confuse patent practitioners and the patent holders they represent about the scope of the patent's protection. In particular, claim construction canons establishing the relationship between the claims and the written description in determining the scope of protection are unclear."); Gretchen Ann Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time Is Ripe for a Consistent Claim Construction Methodology*, 8 *J. Intell. Prop. Law* 175, 175 (2001) ("Trial courts currently struggle with patent claim construction, a critical issue in any patent case."); Russell B. Hill & Frank P. Cote, *Ending the Federal Circuit Crapshoot: Emphasizing Plain Meaning in Patent Claim Interpretation*, 42 *IDEA* 1, 2 (2002) ("The Federal Circuit continues to issue panel-specific contradictory decisions regarding the respective roles of the plain meaning of patent claim terms and the written description in patent claim interpretation.").

Two recent lower court claim construction decisions, issued one week apart, exemplify the confusion extant at the district court level—No. 01-CV-10957-PBS, *VLT Corp. v. Lambda Elects., Inc.*, 2003 WL 76091 (D. Mass. Jan. 3, 2003) and *BorgWarner, Inc. v. New Venture Gear, Inc.*, 237 F. Supp.2d 919 (N.D. Ill. 2002). In *VLT*, the Court stated that "[c]aselaw is a bit schizophrenic on the relationship between the claim language and the specification of a patent, particularly as it concerns embodiments of an invention." 2003 WL 76091, at *2.

In *BorgWarner*, the Court described this area of law as "seemingly ambiguous." Both lower courts noted that this Court recently had attempted to address this "ambiguous" and "confusing area" in *Texas Digital* yet the Northern District of Illinois still concluded that:

> It would seem, however, that there will always be a tension in claim construction between reference to the claim language and reference to the specification, especially given what the Federal Circuit itself suggests is a misleading precedent.[2]

BorgWarner, 237 F. Supp.2d at 928.

The tension between the two lines of cases is particularly acute in relation to the role of the dictionary in the claim construction process. In *Texas Digital*, the Court stated that:

> It has been long recognized in our precedent . . . that dictionaries, encyclopedias and treatises are particularly useful resources to assist the Court in determining the ordinary and customary meanings of claim terms.

308 F.3d at 1202. *Texas Digital* goes on to say that there is a "presumption in favor of a dictionary definition" that may be overcome by review of the intrinsic evidence. 308 F.3d at 1204. *Texas Digital* went on to suggest that it would be a "violation of precedent . . ." to consult the written description and prosecution history prior to consulting a dictionary. This is not consistent with some of its own prior precedents, including *Vitronics*. For example, in *Multiform Desiccants, Inc. v. Medzam, Ltd.*, the Court stated:

> It is the person of ordinary skill in the field of the invention through whose eyes the claims are construed.

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[2] *Texas Digital* suggested that the Court's precedent, emphasizing the role of the specification, may mislead "when it informs that disputed claim terms should be construed in light of the intrinsic record." 308 F.3d at 1205

> *. . . Thus the court starts the decision making process by reviewing the same resources as would that person, viz., the patent specification and the prosecution history. . . .*
>
> . . . .
>
> Courts must exercise caution lest dictionary definitions, usually the least controversial source of extrinsic evidence, be converted into technical terms of art having legal, not linguistic, significance.[3] The best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history. . . . When the specification explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term.[4]

133 F.3d 1473, 1477-78 (Fed. Cir. 1998) (emphasis added.)

It is difficult to reconcile the methodology employed in cases like *Multiform* with that prescribed by *Texas Digital*.[5]

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[3] *Multiform* and *Texas Digital* also do not agree as to whether dictionaries are prohibited "extrinsic evidence." *Texas Digital*, 308 F.3d at 1202 (citation omitted).

[4] At least one commentator has questioned the value of dictionaries to the claim construction process. 5A Donald S. Chisum, *Chisum on Patents*. § 18.03 [2][b][i] (2002)("Dictionaries are often of little assistance because they give multiple and alternative definitions of words."

[5] Perhaps your Amicus may be permitted to offer anecdotal evidence of the potential for confusion based upon his own experience in service as a special master charged with the responsibility for conducting *Markman* proceedings and recommending a construction of the claims to the district court. In several such assignments prior to *Texas Digital*, your Amicus found it very difficult to know, from the Federal Circuit's precedents, what the proper role of dictionaries and treatises was. In matters presently being handled by your Amicus as a special master, every effort is being made to follow the *Texas Digital* methodology. This is proving extremely difficult, just as a logical matter, for the proffered dictionary definitions are usually inconclusive and often inapposite. On the other side of the coin, your Amicus has found it difficult to know, in view of cases like

The Federal Circuit has refused *en banc* rehearing, and it is unlikely that any panel of that Court can realistically hope to accomplish this task with the degree of certainty the issue demands. *Mother's Restaurant, Inc. v. Mama's Pizza, Inc.*, 723 F.2d 1566, 1573 (Fed. Cir. 1983) ("The court may overrule a prior holding having precedential status only by an in banc decision.").

Review of the claim construction issues in this case presents a good opportunity for the Court to settle this area of law. The issues central to the Federal Circuit's reversal of the lower court's claim construction rulings are the same issues that need to be settled. The lower court relied heavily on the same line of claim construction decisions that emphasize the role of the specification. The appellate panel reversed, applying the *Texas Digital* methodology, and began its analysis by first consulting a dictionary and determining that the intrinsic evidence failed to rebut the dictionary definition.

Regardless which claim construction methodology the Court ultimately adopts, there are important questions that need to be resolved. As a single example, if there is to be continued emphasis on the use of dictionaries as the initial step in the process, guidance is required regarding which dictionary or treatise competitors should consult in order to assess the scope of a patentee's claims.[6] It is time to settle this vitally important area of the patent law. I therefore respectfully submit this brief Amicus Curiae in support of Infineon's petition for review by certiorari.

Wang v. AOL, where the dividing line is between construing the claims in *light of* the specification and *importing limitations from* the specification. Compliance with either the *Texas Digital* line of cases or the *Wang* line is not a straightforward matter, and the problem is exacerbated when the lines appear to coexist as ruling precedent. Your Amicus, for one, hopes for guidance from this Court.

[6] Of course there is no doubt as to which intrinsic materials a competitor should review as part of the process—the patent documents are well defined.

Respectfully submitted,

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